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REMARKS

Claims 1-32 were originally presented in the subject application. Claims 33 and 34 were added in a Response dated July 2, 2004. Claims 10, 20-22 and 32-34 were canceled without prejudice in an Amendment dated May 23, 2005. No claims have herein been amended, added or canceled. Therefore, claims 1-9, 11-19 and 23-31 remain in this case.

The addition of new matter has been scrupulously avoided.

Applicants respectfully request reconsideration and withdrawal of the sole ground of rejection.

35 U.S.C. §103 Rejection

The Office Action rejected claims 1-12 under 35 U.S.C. §103, as allegedly obvious over Burk ("UNIX System Administrator's Edition") in view of Deitel ("C & C++ Multimedia Cyber Classroom"). Applicants respectfully, but most strenuously, traverse this rejection.

Deitel Nonanalogous Art

As an initial matter, Applicants submit that Deitel is improperly cited against the present application as nonanalogous art.

The determination that a reference is nonanalogous art involves two steps. *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994); *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (CCPA 1979). First, the reference is reviewed as to whether it is within the field of the Applicants' endeavor. *Id.* Second, if the reference is not in the field of endeavor, then a determination is made as to whether the reference is reasonably pertinent to the particular problem the inventor sought to solve. *Id.*

In determining what the field of endeavor is in the first part of the test, courts have looked to the field of endeavor set out in a patent or patent application. See, e.g., *In re Wood and Eversole*, 202 U.S.P.Q. 171 (CCPA 1979).

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In the present case, the field of endeavor in numbered paragraph 0001 of the present application is set out as relating, in general, to searching techniques, and in particular, to facilitating the searching for text of computer programs by selectively choosing where to search for the text. In contrast, Deitel (the actual cited sections thereof) is directed to the “#include” and “#define” preprocessor directives in the C and C++ programming languages. The #include directive (the portion substantively cited) searches for files, not text, and replace the directive with a copy of the file. The same is true even when Deitel is compared to the preamble of claim 1, for example, which recites searching for text of computer programs. Therefore, Applicants submit that Deitel is not within the field of applicant’s endeavor.

Moving on to the second part of the test, it must be determined whether Deitel is reasonably pertinent to the particular problem sought to be solved by the present invention. In this case, as noted in the Background section of the present application, the problem is that existing text search tools search too many places, which is time consuming and tends to produce false positives. Again, though, Deitel is not a text search tool, but describes a preprocessor directive for finding files and replacing the directive with the contents of the file. Thus, Applicants submit Deitel is not reasonably pertinent to the problem sought to be solved.

Therefore, Applicants submit that Deitel is improperly cited against the present application as nonanalogous art.

Deitel Improperly Combined With Burk

Moreover, even ignoring the nonanalogous nature of Deitel, Applicants submit one skilled in the art would not combine Deitel with Burk as done in the Office Action. As an initial matter, Burk is generally concerned with using UNIX, while Deitel is concerned with the C/C++ programming languages. Moreover, the substantively cited section 17.2 of Deitel concerns a directive for file search and insert in preprocessing (i.e., precompiling), whereas GREP in Burk is directed to text searching in computer programs. Applicants submit that one skilled in the art using GREP simply would not look to Deitel to address any issues with text searching in computer programs.

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Therefore, Applicants submit that one skilled in the art would not be motivated to combine Deitel with Burk.

Substantive Rejection

Even ignoring the nonanalogous nature of Deitel, and the implausible combination of Deitel with Burk, Applicants submit that neither Burk nor Deitel alone, nor their combination, teaches or suggests the presently claimed invention.

Claim 1 recites, for example, determining whether one or more additional items are to be searched for the text, the determining using one or more language specific rules of the computer program to determine whether one or more additional items are to be searched, the determining being defined by the computer program.

Against this aspect of claim 1, the Office Action cites to Burk at page 145, alleging that repeated use of the FIND command reads thereon. However, it is the user in Burk that determines whether and where to search. The above-noted aspect of claim 1 recites that the determining is defined by the computer program, and not the user as in Burk.

Moreover, the determining is also recited to use one or more language specific rules of the computer program. This aspect of claim 1 appears to have been ignored in the Office Action. However, Applicants submit it cannot be ignored, and that it is not taught or suggested by either of the cited references or their combination.

As another example, claim 1 recites searching for the text by the search tool in at least one additional item of the one or more additional items, in response to the determining indicating that one or more additional items are to be searched.

Against this aspect of claim 1, the Office Action cites to the "#include" preprocessor directive of Deitel. However, as noted above, the #include directive searches for a file and inserts a copy of the file in place of the directive. Thus, the Deitel directive is neither a text search tool, nor does it search the text of a computer program, much less doing so in response to the claimed aspect of determining.

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Therefore, for all the reasons noted above, Applicants submit that claim 1 cannot be rendered obvious over Burk in view of Deitel.

Independent claims 11 and 23 include aspects similar to those argued above with respect to claim 1. Thus, the remarks regarding claim 1 are equally applicable thereto. Therefore, Applicants submit that claims 11 and 23 likewise cannot be obviated by Burk in view of Deitel.

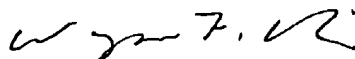
CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-9, 11-19 and 23-31.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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